

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

OCT 19 1999

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LUCRETIA H. VANDERWENDE,
STEPHEN D. RICHARDSON, KAREN JENSEN,
GEORGE E. HEIDORN and
WILLIAM B. DOLAN

Appeal No. 1997-0887
Application 08/227,247¹

ON BRIEF

Before THOMAS, JERRY SMITH and DIXON, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record in this applications leads us to conclude that this case is not in condition for a decision on appeal at this time. Accordingly, we remand the application

¹ Application for patent filed April 13, 1994.

Appeal No. 1997-0887
Application 08/227,247

pursuant to 37 CFR § 1.196(a) and Manual of Patent Examining Procedures (MPEP) § 1211 to the examiner to consider the following issues and to take appropriate action.

In addition to two portions of the specification as filed relied upon by the examiner as alleged admitted prior art, the examiner cites and relies upon the entire 362 pages of the Lenat Book. The examiner makes specific reference only to the brief portion at pages 83 and 84 discussing "Inverses." There is no assertion made by the examiner that any other portion of Lenat further discusses inverses in any applied manner. Data inversions are not even recited in claims 41 and 42. It appears that the examiner has not fully assessed the teaching value of Lenat as it applies to the instant claims on appeal to the extent the examiner cites the entire book. Thus, the unfocused application of a very lengthy applied reference to the claimed invention obfuscates the relevance of Lenat in determining the patentability of the claims on appeal.

There is no alleged nexus from the applied prior art to the specific features of each claim on appeal rejected under 35 U.S.C. § 103 other than a concept-oriented statement of the rejection to all of the claims generally. There is no clause-by-

Appeal No. 1997-0887
Application 08/227,247

clause correlation of the teachings of any of the alleged admitted prior art and Lenat to each of the individual claims on appeal. This applies to each of the independent claims 20, 30, 41 and 43 on appeal as well as each of those specific claims mentioned in the brief at pages 20-22, 24, 27 and 28. The responsive arguments portion of the answer does not specifically point to any portion of the alleged admitted prior art or Lenat that meets, teaches or suggests the limitations of these claims on appeal. Furthermore, no supplemental answer has been filed regarding the allegations in the reply brief of a new ground of rejection with respect to the alleged new references relied upon in the answer. We will not make any of these determinations initially on our own.

The Patent and Trademark Office (PTO's) policy is for the examiner to compare the rejected claims feature-by-feature with the reference(s) relied upon in the rejection. The comparison shall map the language of the claims to the specific page number,

Appeal No. 1997-0887
Application 08/227,247


column number, line number, drawing, reference number, or quotation from the specific reference relied upon to each individual claim on appeal. Note MPEP § 1208 (7th Ed., July 1988).

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure (MPEP) § 708.01(d) (7th Ed., July 1998). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMAND

James D. Thomas.
Administrative Patent Judge

Jerry Smith
Jerry Smith
Administrative Patent Judge


Joseph L. Dixon
Administrative Patent Judge

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Appeal No. 1997-0887
Application 08/227,247

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